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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,081	07/28/2005	Gunter Schmid	008310-000002	8551
30565 7590 01/12/2010 WOODARD, EMHARDT, MORIARTY, MCNETT & HENRY LLP 111 MONUMENT CIRCLE, SUITE 3700 INDIANAPOLIS, IN 46204-5137				
EXAMINER HOLLOMAN, NANNETTE				
ART UNIT		PAPER NUMBER		
1612				
NOTIFICATION DATE		DELIVERY MODE		
01/12/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketDept@uspatent.com

### Office Action Summary

**Application No.**

10/523,081

**Applicant(s)**

SCHMID ET AL.

**Examiner**

NANNETTE HOLLOMAN

**Art Unit**

1612

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 50-55 and 61-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 50-55 and 61-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicants' arguments, filed October 13, 2009, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

#### ***Claim Rejections - 35 USC § 112 (Previous Rejection)***

##### ***1<sup>st</sup> Paragraph-Written Description***

Claims 37-45, 50-55 and 61-63 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is maintained. Claims 37-45 are cancelled.

#### **Applicant's Arguments**

Applicant argues "derivatives" have been excluded or deleted with the amendments to the claims. Applicant's arguments have been fully considered but they are not persuasive.

**Examiner's Response**

The term "derivatives" is still in the claims; therefore the rejection is maintained.

***1<sup>st</sup> Paragraph-Scope of Enablement***

Claims 37-45, 50-55 and 61-63 were rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treatment, does not reasonably provide enablement for "prophylactic". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Claims 37-45 are cancelled.

This rejection is maintained since applicant has not responded to the rejection in a substantive manner.

***Claim Rejections - 35 USC § 102 (Previous Rejection)***

1) Claims 37-38, 40-45, 50-55 and 63 were rejected under 35 U.S.C. 102(b) as being anticipated by Hainfeld et al. (US Patent No. 5,360,895). This rejection is maintained. Claims 37-38 and 40-45 are cancelled.

**Applicant's Arguments**

Applicant argues the reference does not disclose the specific compounds claimed. Applicant's arguments have been fully considered but they are not persuasive.

**Examiner's Response**

It appears the reference discloses similar gold clusters as those claimed, specifically at EXAMPLE 16 the reference discloses preparation of  $\text{Au}_{55}[\text{PPh}_3]_{12}\text{Cl}_6$ ; which meets the limitation of formula (II) of instant claim 50; wherein  $\text{PPh}_3$  is equivalent to  $\text{L}'$  when  $\text{L}$  is triphenylphosphine and  $\text{X}$  is  $\text{Cl}$ . As previously asserted, the reference further discloses the gold clusters are useful for treating cancer and killing cancer tumor cells (column 7, line 59-64). Therefore, the reference encompasses the claimed limitations.

2) Claims 61 and 62 were rejected under 35 U.S.C. 102(b) as being anticipated by Peschel et al. (Angewandte Chemie, Int. Ed., Col. 34, No. 13/14, 1995). This rejection is maintained. This rejection is further applied to claims 50-51 and 63.

**Applicant's Arguments**

Applicant argues the reference does not have anything in common with the current claims since no medical application for these kinds of compounds is envisaged there. Applicant's arguments have been fully considered but they are not persuasive.

**Examiner's Response**

The current claims are directed to metal cluster nanocompounds, which is a product and the intended use of said product is not a limitation to the claims; therefore the disclosure of Peschel of the instant metal cluster nanocompounds of instant claims 61 and 62 encompass the claimed limitation.

In regard to claim 50, the reference discloses the compound of 61 and 62 therefore meeting the limitation of instant claim 50. In regard to the water solubility of instant claim 51; the solubility is a property that is intrinsic to the compound and therefore the compound of Peschel would be expected to have a similar solubility. Peschel et al. disclose gold clusters with a metal core about 1.4 nm (p. 1442, column 1, 3<sup>rd</sup> paragraph), which meets the limitation of instant claim 63.

***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANNETTE HOLLOMAN whose telephone number is (571) 270-5231. The examiner can normally be reached on Mon-Fri 800am-500pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. H./  
Examiner, Art Unit 1612

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/Frederick Krass/  
Supervisory Patent Examiner, Art Unit 1612